

Application No.: 09/369,490

Atty Docket No.: PUMA 1024-1

REMARKS

Claims 89-106 are currently pending in this application. Claims 93 and 102 are currently amended. Otherwise, the rejections based on Butler are traversed without amendment.

Objections to Claims 93 and 102

The Examiner objects to **claims 93 and 102** as substantial duplicates of claims 92 and 101. Applicants appreciate the Examiner's effort to point out that the dependencies of claims 93 and 102 should be amended. Based on the amendments, Applicant respectfully submits that objections to claims 93 and 102 should be withdrawn.

Rejection Under 35 U.S.C. § 102(e) of Claims 89-106

The Examiner rejects **claims 89-106** under 35 U.S.C. § 102(e) as anticipated by Butler et al. (U.S. Patent 6,771,743).

Claim 89

Independent claim 89 includes the limitations:

the parent application intercepting a web page sent from the web server to the embedded browser, the web page including one or more special key tags encoded with instructions to the parent application, wherein the special key tags are not HTML formatting tags;

the parent application responding to the encoded instructions by triggering a special behavior of the parent application, distinct from displaying the web page; and

the embedded browser displaying at least part of the web page other than the special key tags

These limitations are not found in Butler. Butler's abstract describes:

A voice processing system, method and computer program product therefor, allows **telephone callers without computers to access World Wide Web** pages from the Internet. Usual graphical-based Hyper-Text Mark-Up language (HTML) commands are interspersed with special HTML tags including the commands and data for forming a voice application, which, when run on the voice processing system, provides a voice browser for allowing telephone callers to access Web pages. ...

The Examiner characterizes the voice processing system as the "parent application".

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Butler never characterizes the voice processing system as having an “embedded browser displaying at least part of the web page”. The passage on which the Examiner relies does not read on this element either:

In the preferred embodiment a specific dialled phone number is recognized and used by the voice processing system 2 to retrieve a corresponding Web home page (initial Web page for first presenting to the caller) from the Internet. This Web home page is accessed by the voice processing system 20 2 from the data communications network 3 via line 13 of FIG. 1.

Col. 5, lines 17-23. Merely retrieving a web page via the Internet is not enough to read on the element.

Further along, the Examiner argues that col. 6, lines 3-8 read on the “embedded browser displaying at least part of the web page”. The cited passage reads:

```
<IMG src=“./company_logo.gif” alt=“Company  
Logo”><BR>
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5 This first line of HTML code is not for use by the telephone user. For the computer-based user the graphical Web browser will display a graphical image of the company logo on the client computer’s display screen.

This extract makes it clear that neither the voice recognition system (parent application) nor any “embedded browser” within the voice processing system displays the web page to “telephone callers without computers”. See, Butler, abstract.

Fundamentally, the voice processing system and graphical Web browser mentioned in Butler are disjoint interfaces that use different physical and logical layers (standard telephone lines without a computer vs. Internet access and an HTML browser on a computer) to extract data from a web page. Looking to Butler’s voice processing system, the Examiner cannot show that voice processing includes an embedded browser, much less one that displays part of the web page to a caller “over a standard telephone”. See, Butler, col. 5, lines 31-32.

Looking to Butler’s graphical Web browser, which can access the same web page as the voice processing system, there is no teaching for that browser to be

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embedded in a parent application, much less the voice processor that the Examiner identifies as the parent application. To the contrary, Butler teaches that the browser ignores the non-HTML tags destined for the voice processing system. Col. 6, lines 15-18.

Therefore, claim 89 should be allowable over Butler.

Claim 98

Independent claim 98 includes the limitations:

computer-implemented logic adapted to:

intercept a web page from the web server addressed to the embedded browser, the web page including one or more special key tags encoded with instructions to the parent application, wherein the special key tags are not HTML formatting tags;

trigger special behavior of the parent application in response to the encoded instructions, distinct from displaying the web page; and

pass to the embedded browser at least part of the intercepted web page for the embedded browser to display

These limitations are not found in Butler, for the reasons given above.

Therefore, claim 98 should be allowable over Butler.

Claims 90-93 and 96-97

Dependent claims 90-93 and 96-97 include limitations such as:

(90) further including the parent application removing the special key tags from the web page and passing the revised web page to the embedded browser for display.

(92) further including, as the special behavior of the parent application, presenting a set-up dialogue to configure the parent application.

(96) further including, as the special behavior of the parent application, customizing the web page with user-specific information accessible to the parent application and not provided in the intercepted web page.

(97) further including, as the special behavior of the parent application, invoking a handler routine responsive to instructions in auxiliary information that is part of the special key tags.

These limitations are not found in Butler. (Claim 91 is allowable for at least the same reasons as claim 89 from which it depends.)

Regarding claim 90, the Examiner cites col. 6, lines 14-37, which explains that the Web browser receives but ignores the special key tags that the voice processing

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system would use. Even if the Web browser were embedded in the voice processor, which it is not, Butler would teach passing the whole page to the browser and letting it ignore the special tags, which does not read on claim 90.

Regarding claim 92, the Examiner cites col. 6, lines 38-45, which Butler explains as leading the telephone caller to "hot discounts" information, by traversing a telephone tree, by pressing "1" on their dial pad. Applicant does not find any discussion in this passage of *"presenting a set-up dialogue to configure the parent application"*.

Regarding claim 96, the Examiner confuses "Dialed Number Identification Service" (DNIS) with caller-id. The voice processing system uses DNIS to identify the web page being accessed, not to identify the caller. Applicant does not find any discussion in col. 5, lines 9-23 of *"customizing the web page with user-specific information accessible to the parent application and not provided in the intercepted web page"*.

Regarding claim 97, the use of handler routines is not expressed by Butler and not so unavoidable in implementing a voice application as to qualify to be "inherent" in the sense of logically necessary. See MPEP § 2112 at 2100-54 to 55 (Rev. 2, May 2004).

Therefore, claims 90-93 and 96-97 should be allowable over Butler.

Claims 99-102 and 105-106

Claims 99-102 and 105-106 include limitations similar to claims 90, 92 and 96-97, and should be allowable for at least the reasons stated in the preceding section.

Claims 103 and 104

Claims 103 and 104 include the limitations:

(103) further including, as the special behavior of the parent application, modifying a system registry entry corresponding to the parent application.

(104) wherein the system registry entry includes at least one name/value pair.

The Examiner rejects claim 103 (OA at 7, ¶ 3) without attempting to find support in Butler and overlooks rejecting claim 104.

Applicant respectfully submits that claims 89-106 should be allowable over Butler.

Application No.: 09/369,490**Atty Docket No.: PUMA 1024-1****Rejection Under 35 U.S.C. § 103(a) of Claims 94-95 and 103-104**

The Examiner rejects **claims 94-95 and 103-104** under 35 U.S.C. § 103(a) as unpatentable over Butler et al. (U.S. Patent 6,771,743) in view of Larson et al. (U.S. Patent 6,408,326).

Having failed to make a *prima facie* case of anticipation of claims 103-104 (which have limitations similar to claims 94-95), the Examiner argues obviousness. OA at 8-9. Only Butler's voice processing system responds to special tags, so the issue is whether Larson can be combined with the voice recognition system in a way that modifies a system registry entry for the voice recognition system. Larson is a Microsoft-assigned patent that describes enforcing network-administrator policies on individual local machines by modifying registry values on the individual local machines as part of a user login sequence. See, figures 3A-3B.

First, the Examiner asserts that Butler and Larson are in analogous arts, but does not explain why. The Butler "parent application" that the Examiner is applying is a voice processor program that responds to user requests to browse a web page without requiring a user login. One would assume that this voice processor serves multiple callers. The input to the voice processor is limited by what a caller can do with a standard telephone. The voice processor is a server, not an individual local machine with user-modifiable registry settings. The Larson reference provides a tool that allows a system administrator controlling a login server to set policies that are implemented when users login to individual machines using the login server (e.g., a Word program setting for whether to correct TWoInItialCaps). While both references describe computer-implement technology, that is not enough to place them in analogous arts.

The combination, were the reference in analogous arts, which they are not, would not read on claims 94-95 and 103-104. Larson depends on a login and Butler's user does not login. Larson depends on a user identification and Butler's users do not identify themselves. Larson implements system policies before any browser is opened by a user. Butler's special tags are directed to delivering voice messages to users, not to triggering a behavior that includes setting values in a system registry.

It is fundamental, as indicated in MPEP Section 2143.01, that the Examiner rely on some evidentiary quality suggestion from one of the references to modify Butler:

Obviousness can only be established by combining or modifying the

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teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The MPEP cites *In re Lee*, in which the Federal Circuit clarified the need for evidentiary quality support of an examiner's factual basis for finding a teaching, suggestion or motivation in the prior art (as opposed to an examiner's opinion), 277 F.3d at 1343-44:

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 U.S.P.Q. (BNA) 769, 775 (Fed. Cir. 1983). ... "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [citation omitted] The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). ... In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

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The outcomes of cases decided even before *In re Lee* make it clear that real evidence is required to support an asserted teaching, suggestion or motivation to modify a reference to support an obviousness finding. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000) (rev'd finding of obviousness, as "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference."); *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541 (Fed. Cir. 1997) (aff'd patent not invalid, as no suggestion to modify the '989 patent with regard to non-metallic fibers). The Examiner has not produced the required objective evidence that would "lead that individual [of ordinary skill] to combine the relevant teachings of the references." *In re Fritch*, cited in *In re Lee* (above).

Applicants did not find in Butler or Larson any suggestion or teaching to modify a voice processor to enforce system administrator policies for users at login. The Examiner argues:

It would have been obvious to one ordinary [sic] skilled in the art at the time of the invention to combine the teachings of Butler and Larson, because Larson's method of building system registry for applications using name/value pair would not only provide an extensible and portable mechanism for parent application (such as voice processing system) for applying parent application control regarding each user in a predetermined format (such as name/value pair format), but would also provide uniform mechanism of updating, and enforcing a particular control (policy) value and configuration for applications (parent application) for each user using the (parent) application.

OA at 9. But this is a statement of the *result* of combining the references using the claim as a blueprint (20-20 hindsight), which is impermissible. 2-5 Chisum on Patents § 5.03 [2][c] n. 29 (2005 Lexis version); e.g. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998) ("Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention."); *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988) ("Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.'"). This claimed

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motivation ignores how the voice processor works. It reconstructs the voice processor interaction with the user in a way that neither Butler nor Larson suggests, using the claim as a blueprint for the reconstruction. Therefore, the combination is improper.

Applicant respectfully submits that claims 94-95 and 103-104 should be allowable over Butler in view of Larson.

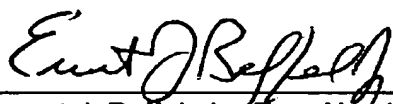
CONCLUSION

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims as now stated.

Applicants would welcome an interview, if the Examiner is so inclined. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 to 5:30 PST, M-F and can be reached at his cell phone (415) 902-6112 most other times.

Respectfully submitted,

Dated: 14 June 2005


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